

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Julia Adam-Worrall et al.

Application No.: 10/590,674

Confirmation No.: 2842

Filed: August 26, 2006

Art Unit: 1626

For: (INDOL-3-YL)-HETEROCYCLE
DERIVATIVES AS AGONISTS OF THE
CANNABINOID CB 1 RECEPTOR

Examiner: Sun Jae Y Loewe

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

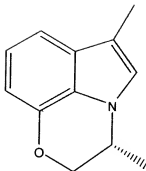
Dear Sir:

INTRODUCTORY COMMENTS

This is in response to the Office Action dated November 2, 2007 having a shortened statutory one-month period for response which expires on December 2, 2007.

Applicants herein authorize any and all charges due to such extension be charged to its Deposit Account No. 50-4205.

The Examiner has indicated that the claimed subject matter is drawn to eight distinct inventions and has required restriction to one of the following inventions: Group I, claims 1-6, 8, 12 and 13 drawn to products of formula 1 wherein R2/R7 do not form a ring and R1=cyclohexyl; Group II, claims 1-6, 8, 12 and 13 drawn to products of Formula 1 wherein R2/R7 do not form a ring and R1=tetrahydropyranyl; Group III, claims 1-3, 5, 6, 8, 12 and 13 drawn to products of Formula 1 with the the following structural limitations: R2 and R7 together form



R1=cyclohexyl; Group IV, claims 1-6, 8, 12 and 13 drawn to products of Formula I not covered by Groups I-III; Group V, claims 10, 11, 14 and 15 drawn to process of using products of Group I; and Group VI, claims 10, 11, 14 and 15 drawn to process of using products of Group II; Group VII, claims 10, 11, 14 and 15 drawn to process of using products of Group III; and Group VIII, claims 10, 11, 14 and 15 drawn to process of using products of Group IV.

Applicants provisionally elect, with traverse, to prosecute the invention Group II (claims 1-6, 8, 12 and 13 drawn to products of Formula I wherein R2/R7 do not form a ring and R1=tetrahydropyranyl). Applicants further elect the species of formula I, 7-chloro-3-(5-{[N-ethyl-N-(2-methoxyethyl)amino]methyl}-[1,2,4]-thiadiazol-3-yl)-1-(tetrahydropyran-4-yl)methyl-1H-indole, which reads on claims 1-6, 8, 12 and 13. Applicants expressly reserve the right to file a divisional application directed to the non-elected claims of this application in the event the Examiner's requirement for election becomes final.

Applicants respectfully request that the restriction requirement be reconsidered at least with respect to Groups I and II, and withdrawn. Applicants submit that R1=cyclohexyl (Group I) and R1=tetrahydropyranyl (Group II) can be considered members of the same type of group and are defined in the specification as members of the same group, i.e., 5-8 membered saturated carbocyclic ring, and thus should not be grouped separately. Further, from a chemical point of view it is logical to include both R1=cyclohexyl and tetrahydropyranyl in one group, since preparation of the

compounds of formula I having either a cyclohexyl as R1 or a tetrahydropyranyl as R1 involves, *inter alia*, utilizing the same procedure as described on page 8, lines 18-28. Consequently, separation of the invention into Group I, R1=cyclohexyl and Group II, R1=tetrahydropyranyl appears to violate the rule of one general inventive concept.

It is also respectfully submitted that the Examiner would not suffer an undue burden of searching since both rings are defined as carbocyclic and are attached to a common structural moiety, an indole ring. The current invention may be logically grouped into six distinct series:

Group I, claims 1-6, 8, 12 and 13, wherein R2/R7 do not form a ring and R1=cyclohexyl, tetrahydropyranyl;

Group II, Claims 1-3, 5, 6, 8, 12 and 13 drawn to products of Formula I with the specified structural limitation;

Group III, Claims 1-6, 8, 12 and 13 drawn to products of Formula I not covered by Groups I-II;

Group IV, claims 10, 11, 14, and 15 drawn to process of using products of Group I;

Group V, claims 10, 11, 14, and 15 drawn to process of using products of Group II;

Group VI, claims 10, 11, 14 and 15 drawn to process of using products of Group III.

Applicants retain the right to petition from the Restriction Requirement under 37 C.F.R. §1.144.

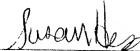
Application No. 10/590,674
Amendment dated November 28, 2007
Reply to Office Action of November 2, 2007

Docket No.: 2004.831US

Early and favorable action is respectfully requested.

Dated: November 28, 2007

Respectfully submitted,

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